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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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Confirm. No. : 7408
Inventor: Jeffrey D. Ollis et al.
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Title: System and Method for Dynamic Alternative Route Geographic Plotting
Examiner: Mancho, Ronnie M.
Art Unit: 3663
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Commissioner for Patents
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APPEAL BREIF

In response to the Final Rejection mailed on April 19, 2007 and the Advisory Action mailed on June 7, 2007, please enter this Appeal Brief. The Notice of Appeal is filed herewith.

(I) *Real Party in Interest*

General Instrument Corporation, a wholly owned subsidiary of Motorola, Inc., is the real party in interest.

(II) *Related Appeals and Interferences*

There are no known related appeals or interferences.

(III) *Status of the Claims*

Claims 1-5 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent Application Publication No. 2004/0093154 to Simmonds et al.

(IV) *Status of Amendments*

There are no amendments to the claims after Final Rejection.

(V) *Summary of the Claimed Subject Matter*

The invention is a system for dynamic alternative geographic route plotting. The system includes an audio tuner for tuning to frequencies that carry radio broadcast signals. *See* paragraph [0024]; Figure 1, element 102. The system also includes a selection recognition engine that monitors the tuned radio broadcast signal looking for pre-defined recording triggers. *See* paragraph [0025]; Figure 1, element 106. The selection recognition engine further records, to a memory, portions of a radio broadcast signal. *See* paragraph [0026]. Once recorded, the selection recognition engine processes the recorded radio broadcast signals for anomaly information using voice recognition.

See paragraph [0028]. That is, the pre-defined audio broadcast signal (“PABs”) is converted into a text string via voice recognition. See paragraphs [0011] and [0028]. Once an anomaly text string (“ATS”) is detected, it is forwarded to a global positioning satellite (“GPS”) device. See paragraph [0028]. The GPS device then determines an alternative route for the driver based on the received ATS. *Id.*

A use case will also help with understanding this invention. Suppose a driver has instructed his car’s GPS system to map a route from Alexandria, Virginia to Baltimore, Maryland. As the user listens to broadcast radio, the DJ announces, “Let’s check in with traffic and our man in the sky David Smith.” In one implementation, the selection recognition engine will determine that the word “traffic” is important and begin recording portions of the broadcast. That is, the word “traffic” is an illustrative recording trigger.

The traffic man David Smith will then announce his traffic report. Suppose he states, “Heavy traffic on I-495, outer loop, near the Pennsylvania Avenue exchange.” If the original route was to take I-495, outer loop, up to I-95 and Baltimore, the GPS system will then re-evaluate its route and determine that with phrases like “heavy traffic,” “I-495,” “outer loop,” and “Pennsylvania Avenue,” in the recorded radio broadcast, that an alternative route is needed. The GPS system can then direct the driver to take I-295 North and bypass the heavy traffic on I-495 near Pennsylvania Avenue.

(VI) Grounds of Rejection to be Reviewed on Appeal

Whether the rejection of claims 1-5 under 35 U.S.C. 102(e) as being anticipated by U.S. Patent Application Publication No. 2004/0093154 to Simmonds et al. is proper.

(VII) Argument

Claim 1 recites using voice recognition to extract the anomaly information from recorded portions of radio broadcasts. Simmonds et al. do not do this. Instead, Simmonds et al. send encoded messages that can be understood by the VCSI 30 in FIG. 2. *See generally*, paragraphs [0044] and [0058]. Nowhere in Simmonds et al. is voice recognition used to extract data from a radio broadcast message.

The Examiner also refuses to address the point that Simmonds et al.'s voice recognition circuitry is designed to receive voice inputs from the driver and not the radio broadcast. See paragraphs [0036], [0075] and [0088]. The Examiner relies on paragraphs [0036] and [0075] for support in making the rejection. There is simply no mention in either of those paragraphs that the voice recognition circuitry of Simmonds et al. receives voice signals from the radio broadcast. Thus, the Examiner's assertion that he "actually cited the columns and lines where the limitations in the claims are disclosed," is incorrect. *See* Advisory Action mailed on June 7, 2007.

To get around this failing in Simmonds et al., the Examiner continues to assert that the claim limitation of using voice recognition to extract anomaly information is a statement of intended use and "does not further distinguish the structure of the invention over the prior art." See Final Rejection mailed on April 19, 2007; page 5. By this assertion, the Examiner is reading this limitation out of the claim. It is improper for the Examiner to ignore this limitation in an effort to make Simmonds et al. "stick" to the present claims.

The Examiner has ignored limitations in the claims because they are allegedly statements of intended use and cites to MPEP 2114 for support in making this

determination. This is improper. *See generally Pac-Tec, Inc. v. Amerace Corp.*, 903 F.3d 769, 801 (Fed. Cir. 1990) (“functional language, in cases like the present, cannot be disregarded”) and *MIT v. Abacus Software*, 462 F.3d 1344, 1356 (Fed. Cir. 2006) (“The claim language here too does not merely describe a circuit, it adds further structure by describing the operation of the circuit”).

The Examiner has failed to address the holdings of *Pac-Tec* or *MIT*. Instead of discussing these cases, the Examiner cites to other cases. These cases do not support the Examiner’s contentions.

First, *In re Pearson*, 494 F. 2d 1399, 181 USPQ 641 (CCPA 1974) does not stand for the broad conclusion that statements of intended use cannot be used to patentably distinguish a claim over the prior art. The holding of *Pearson* supports a different conclusion. That is, a patent claim cannot be allowed over the prior art when the only difference is an inherent property that is expressly claimed in the claimed, but otherwise known in the prior art. Thus, in the case of *Pearson*, not only was the composition of the chemical to improve peanut yields known, so was the benefit of that compound to improve peanut yields. Indeed, the Court in *Pearson* went on to say in that opinion that a blanket rule such as “terms which recite the intended use or a property of a composition can never be used to distinguish a new from an old composition” should not be used. *Id* at 1403. Instead, the Court did say that “such terms[, in order for patentability to rest upon,] must define, indirectly at least, some characteristic not found in the old composition.” *Id*. In the present application, Applicant has claimed limitations that are not found in Simmonds et al. and has therefore done that which was ruled upon by the *Pearson* court.

In re Yanush, 177 USPQ 705, 477 F.2d 958 (CCPA 1973) dealt with a difference in degree. The claims at suit were directed to a method for making footwear. The prior art had a process where vibrations were used to settle material in a mold. The claims “hammered” the material rather than “vibrated” it. The Court held that the difference between “vibrated” and “hammered” was insubstantial. Because the Court found no difference between vibrating and hammering, the Court held that the statement of intended use of hammering did not distinguish the claims over the prior art. The Court did not assert that the term “hammering” was immaterial as alleged by the Examiner. Instead, the Court found “hammering” and “vibrating” to be patentably the same, and with all other limitations also being taught in the prior art, upheld the rejection of the claims. The present application is distinguishable from *Yanush* because Simmonds et al. do not use voice recognition to extract data from a radio broadcast. Thus, there is nothing analogous to this limitation in Simmonds et al.

In re Finsterwalder, 435 F.2d 1028, 168 USPQ 530 (CCPA 1971) dealt with the issue of inherency in a reference. The applicant’s claimed invention was to a platform used in constructing bridges. The claim at issue included the phrase “torsionally rigid.” The prior art had a similar structure to that claimed but did not describe its relevant parts as being torsionally rigid. The Court found that the prior art I-beams were shown to be connected in such a way, and to be composed of steel, such that they would be torsionally rigid. Therefore, the statement of intended use was inherent in the prior art and could not serve as a patentably distinguishable feature. This is not the same as the present case. Simmonds et al.’s voice recognition unit detects the driver’s voice and not the voice retrieved from a radio broadcast. There is simply no circuitry in Simmonds et al. to get

the radio broadcast voice into Simmonds et al.'s voice recognition circuit that is only described for receiving voice commands from the driver.

In re Otto, 136 USPQ 458, 312 F.2d 937 (CCPA 1963) dealt with curlers for curling hair. The Applicant's apparatus claim was:

1. As a new article of manufacture, a core member for hair curlers comprising a body of elastically resilient foam material, the hair being wound directly on said body and said body carrying a hair waving lotion in non-liquid form distributed in the pores of the material.

The prior art included other hair curling structures and structures for holding non-liquid chemicals that could be activated when wet. Again, the Court found that the applicant's statements of intended use (hair being wound and carrying a hair waving lotion in non-liquid form) were taught in the prior art. Therefore, there was nothing patentably distinguishable about these statements over the prior art.

In *Ex parte Masham*, 2 USPQ 2nd 1647 (BPAI 1987), the applicant's claim included a recitation of a mixing means being completely submerged in the developer material. The prior art had a similar mixing means but was only shown to be partially submerged in the developer material. In rejecting this claim, the Examiner reasoned that the prior art mixer was capable of being completely submerged in the developer material. The Board of Patent Appeals and Interferences upheld this finding. The holding of *Masham* is in line with the cases previously discussed. Again, there was an inherent capability of the prior art that met the claimed limitation of being completely submerged. A statement of intended use cannot be used to distinguish over the prior art that inherently performs, or is inherently capable of performing, the claimed statement of

intended use. The present application differs from this situation because Simmonds et al. is not inherently capable of performing voice recognition on a radio broadcast signal.

In re Danly, 263 F.2d 844, 120 USPQ 528 (CCPA 1959) dealt with tie rods in power presses in which the tie rods must be with the correct tension. The claims at issue dealt with passing alternating current through the tie rods to heat them so that when the alternating electric current was later removed from the tie rods, they would shrink and apply the correct tension. The prior art described heating the tie rods using an electric current that would then allow the tie rods to later cool when the current was removed and thereby apply the correct tension. The prior art was not specific as to whether the electric current was alternating or direct. All the structural elements of the pending claims were also found in the prior art. The court held that the teaching of applying electric current was broad enough to cover both alternating and direct currents. Thus, once again, the statement of intended use was found in the prior art and couldn't be used as a basis for finding patentability. As has been previously discussed, Simmonds et al. does not inherently teach some of the claimed features.

In Hewlett-Packard Co. v. Bausch & Lomb Inc., 909 F.2d 1464, 15 USPQ2d 1525 (Fed. Cir. 1990) , Hewlett-Packard ("HP") sued Bausch & Lomb ("BL") for patent infringement. The patent covers plotters that move paper underneath a pen so graphs and charts can be drawn. BL asserted that the patent was obvious, and therefore invalid, in view of one piece of prior art. The HP patent used a wheel with grit on it to keep the paper from slipping as it is moved the paper. The BL prior art used a wheel with a knurled surface to move the paper.

BL apparently admitted that the knurled wheel of the prior art was a different structure than the gritted wheel of the HP patent. BL went on to argue that it would have been obvious to one of ordinary skill in the art to replace the knurled wheel of the prior art with a gritted wheel because a gritted wheel would have the same operational performance (i.e., reduced amount of slippage) as a knurled wheel.

This argument by BL was incorrect and therefore rejected by the Court. BL attempted to reduce the structure claim of HP's patent to the function performed and thereby disregard the structural limitations of the claims (i.e., a gritted wheel). This is what the Court meant when it stated, "[a]pparatus claims cover what a device is [a gritted wheel], not what a device does [anything that reduces slippage]."

In this application, Applicant has claimed a different structure by virtue of its different functions from that of Simmonds et al. The Examiner has failed to address these differences.

Nowhere in the prosecution history does the Examiner address the issue of Simmonds et al. using encoded messages to transmit data to the VCSI 30. This is a fact of Simmonds et al. In order to make any reasonable effort at making Simmonds et al. apply to the claims, the Examiner must modify Simmonds et al. to replace the encoded messages and add or modify the voice recognition circuitry so that it receives data from a radio broadcast. This would require the Examiner to reject the claims under 35 U.S.C. 103(a) and not 35 U.S.C. 102(e). Since the Examiner is using 35 U.S.C. 102(e) as the basis for the rejection and not 35 U.S.C. 103(a), the rejection is improper.

In addressing this argument, the Examiner makes two mistakes. First, the Examiner asserts that "using encoded messages to transmit data to the VCSI 30 is

irrelevant since the applicant is arguing features not claimed.” *See* Advisory Action mailed on June 7, 2007. The Examiner has mischaracterized Applicant’s argument. Using the encoded messages is a feature of Simmonds et al. that limits its applicability as prior art against the present application. Specifically, because using the encoded messages is a feature of Simmonds et al., and not the present claims, Simmonds et al. does not use voice recognition to extract data from a radio broadcast. Therefore, Simmonds et al. does not teach all of the claimed limitations.

Finally, the Examiner’s assertion that Applicant has admitted that the present invention is obvious in view of Simmonds et al. is flat out wrong. *See* Advisory Action mailed on June 7, 2007. Applicant merely pointed out that Simmonds et al. does not teach all of the claimed limitations. In order to arrive at the claimed invention using Simmonds et al., the Examiner, and not one of ordinary skill in the art, would have to modify Simmonds et al. Applicant was merely characterizing the improperness of the Examiner’s rejection and not making an admission about any possible obviousness of the present invention.

For at least these reasons, the Examiner’s rejections are improper and should be reversed.

(VIII) Claims Appendix

A copy of the claims, as amended by the amendment filed herewith, is attached.

(IX) Evidence Appendix

No additional evidence is provided in an evidence appendix.

(X) *Related Proceedings Appendix*

No related proceedings are provided in a related proceedings appendix.

Respectfully submitted,

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CLAIMS APPENDIX

1. A system for dynamic alternative geographic route plotting using global positional satellite data, said system comprising:
 - an audio tuner, said audio tuner tuning frequencies for reception of radio broadcast signals;
 - a selection recognition engine coupled to said audio tuner, said selection recognition engine monitoring said radio broadcast signals for pre-defined recording triggers and selectively recording portions of a radio broadcast signal, said selection recognition engine extracting anomaly information from said recorded portions using voice recognition; and
 - a global positional satellite device, said global positional satellite device receiving said anomaly information and generating at least one alternative route in response to said anomaly information.
2. The system of claim 1 further comprising an audio capture memory coupled to said selection recognition engine, said audio capture memory storing recorded portions of said radio broadcast signal.
3. The system of claim 2, wherein said audio capture memory comprises at least one of random access memory, flash memory, a hard drive, optical drive, and optical-magnetic drive.
4. The system of claim 1 wherein said radio broadcast signal comprises a primary band signal.

5. The system of claim 1 further comprising a display.